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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,038	12/15/2006	Josef Schneider	407PUS	9342

27799 7590 08/31/2010

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EXAMINER	
EVANISKO, LESLIE J	
ART UNIT	PAPER NUMBER
2854	

MAIL DATE	DELIVERY MODE
08/31/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/586,038	SCHNEIDER ET AL.	
	Examiner	Art Unit	
	Leslie J. Evanisko	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 July 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 January 2010* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumaru et al. (JP 08-290543 A) in view of Fuhrmann et al. (US 6,631,677 B1).

With respect to claim 32, Katsumaru et al. teach a device for printing on a substrate, the device comprising at least one printing unit B, B1 configured to print a static or unchanging image on the substrate 1, at least one printing device 9, installed inline with the at least one printing unit B, B1, and configured to individualize the static image by adding at least one

dynamic or changing image to the substrate, each the at least one printing device 9 used to print at least one dynamic or changing image receiving a data stream (via controller 10) containing data for the at least one dynamic or changing image; wherein the image information is printed inline of the substrate in a single workflow. See, in particular, Figure 1 and the attached partial English language translation.

With respect to the language added to claim 32 regarding the printing device being "configured to" print at least one of fragrances, varnishes, electrical conductors and semiconductor circuits, it is noted that claim 32 is drawn to a device for printing per se and not the combination of the printing device and the particular substance being printed. Furthermore, the "configured to" language is a functional intended use and recites no additional structural limitation in the claim necessary to provide that function. Additionally, it is noted that the printing device of Katsumaru does print a material with a particular consistency (in this case, a fluid such as ink) and therefore the device is broadly "configured to" print (or be capable of printing) any desired material with a similar consistency, such as liquids including fragrances, varnishes, or conductive materials used to form conductors and circuits. Therefore, since Katsumaru et al. teach a printing device having all of the structure as recited, it is broadly "configured to" print any desired material such as fragrances, varnishes, electrical conductors or semiconductor circuits to provide different image characteristics to the dynamic or changing image.

Furthermore, Katsumaru et al. is silent with respect to the details of how the static or unchanging image is formed in the printing unit and whether the unit is configured to receive a data stream containing data for the static or unchanging image. However, printing units

configured to receive data for the static or unchanging image and to perform in-press imaging of the print drum are well known in the art as exemplified by the press of Fuhrmann et al. In view of this teaching, it would have been obvious to provide the printing unit of Katsumaru et al. to be configured to receive a data stream containing data for the static or unchanging image as taught by Fuhrmann et al. to allow for a more versatile printing device that is capable of in-press imaging of the plate drum.

With respect to claim 33, note the printing unit for the static or unchanging image of Katsumaru et al. is an offset press B, B1 as shown in Figure 1 and described in paragraph [0010] of the attached partial English language translation.

With respect to claim 34, note the printing device for the dynamic or changing image in Katsumaru et al. is an ink-jet printer 9 as shown in Figure 1 and described in paragraph [0010] of the attached partial English language translation.

With respect to claim 35, Katsumaru et al. in view of Fuhrmann et al. teach a device as recited with the exception of the at least one printing device used to print the dynamic or changing image being based on the principle of electrophotography, magnetography, electrocoagulation, or ionography. However, the use of these various types of digital printing devices to print image information is well known in the art. In view of this, it would have been obvious to one of ordinary skill in the art to provide at least one printing device based upon the principle of electrophotography, magnetography, electrocoagulation or ionography in the device of Katsumaru et al. in view of Fuhrmann et al. as it would simply require the obvious substitution of one known digital image printing device for another. Furthermore, the system of Katsumaru et al. in view of Fuhrmann et al. would perform equally well with a printing system

based upon electrophotography, magnetography, electrocoagulation, or ionography instead of an inkjet printing device to provide the dynamic or changing image on the substrate.

With respect to claim 36, note the device of Katsumaru et al. in view of Fuhrmann et al. can broadly be considered to include a control unit that can broadly be considered to be either "open-loop" or "closed-loop" as recited.

With respect to claim 37, note the device of Katsumaru et al. as modified by Fuhrmann et al. would inherently include at least three data streams. In particular, note Katsumaru et al. teaches the device can include a plurality of inkjet heads (see paragraph [0015]) and there would clearly be a data stream of image information required for each inkjet head. Furthermore, note the printing unit of Katsumaru et al. as modified by Fuhrmann et al. is a double-sided print unit and therefore would require multiple data streams of image information in order for each plate cylinder to be imaged. Thus, the device of Katsumaru et al. in view of Fuhrmann et al. includes three data streams as recited.

With respect to claims 38-39, again it is noted that the particular data printed by the printer is not part of the positively claimed structure of the printing device and therefore the printing device of Katsumaru et al. is capable of being used to print any desired data, such as text data, image data, and/or logistics data to provide different image characteristics to the dynamic or changing image.

Response to Arguments

4. Applicant's arguments filed July 29, 2010 have been fully considered but they are not persuasive of any error in the above rejections.

In particular, applicant argues that Katsumaru fails to teach at least one printing device "configured to print at least one of fragrances, varnishes, electrical conductors and semiconductor circuits" since there is no teaching in Katsumaru that the inkjet heads prints anything other than ink. The Examiner disagrees with this argument. In particular, with respect to the "configured to print" language added to the claims, it is the Examiner's position that this language is still a functional intended use of the printing device since the particular substance (i.e., at least one of the fragrances, varnishes, electrical conductors and semiconductor circuits) being printed is not a positively recited structural element of the device. It is further pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the Examiner's position that the printing device of Katsumaru is capable of printing substances such as fragrances, varnishes, electrical conductors and semiconductor circuits and thereby meets that limitation in the claim.

In view of the above reasoning, the Examiner is not persuaded of any error in the above rejections.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leslie J. Evanisko /
Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
August 29, 2010